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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,857	12/08/2000	Robin R. Miles	IL-10632	2019

24981 7590 08/12/2003

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA
LAWRENCE LIVERMORE NATIONAL LABORATORY
PO BOX 808, L-703
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EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,857

Applicant(s)

MILES ET AL.

Examiner

ALEX NOGUEROLA

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Response to Arguments

1. Applicant's arguments filed July 18, 2003 have been fully considered but they are not persuasive.

35 U.S.C. §102(a) Rejections – Morishima et al.

Applicant has requested withdrawal of the rejections of claims 1, 3, 5, and 6, which were rejected under 35 U.S.C. §102(a) as being anticipated by Morishima et al. The rejections are withdrawn; however, not because Morishima et al. is inapplicable under 35 U.S.C. §102(a).

Applicant states, "The publication date of the Morishima et al. reference is May 14-18, 2000, which is only seven (7) months prior to the December 8, 2000 filing date of the subject application." Applicant has apparently confused a rejection under 35 U.S.C. §102(b) with a rejection under 35 U.S.C. §102(a). "For 35 U.S.C. §102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work." MPEP 706.02(a). Morishima et al. was published before Applicant's effective filing date, is not Applicant's own work, and teaches Applicant's claimed invention. Thus, Morishima et al. is a valid reference under 35 U.S.C. §102(a).

The 35 U.S.C. §102(a) rejections under Morishima et al. are withdrawn because Applicant's Declaration under 37 CFR § 1.131 has established conception and reduction to practice of the invention prior to June 4, 1999, which is prior to May 18, 2000, the publication date of Morishima et al.

Art Unit: 1753

35 U.S.C. §103(a) Rejections – McBride et al. in view of Becker et al.

Applicant has submitted a Declaration under 37 CFR § 1.131 (“Declaration”) to overcome the 35 U.S.C. §103(a) rejections of claims 1-6 as being obvious over McBride et al. (US 6,296,752 B1), Becker et al. (US 6,287,832 B1), and Bakewell et al. (“Characterization of the dielectrophoretic movement of DNA in micro-fabricated structures”). The Declaration establishes conception and reduction to practice of the invention prior to June 4, 1999, which is the filing date of McBride et al., and continuous working on the invention by the Inventors until filing of the application. However, Applicant has not overcome the *effective* filing date, which for McBride et al. is at least October 06, 1998,¹ when the last provisional application was filed. For Becker et al. the *effective* filing date is February 23, 1996, the filing date of the parent application. For Bakewell et al. Applicant’s Declaration must show invention prior to March 31, 1999. See page 700-222 of the MPEP (Rev. 1, Feb. 2003) (MPEP 715) and page 2100-95 of the MPEP (Rev. 1, Feb. 2003) (MPEP 2136.03).

35 U.S.C. §103(a) Rejections – Morishima et al. in view of Bakewell et al.

Applicant requests that the rejections of claims 2 and 4 under 35 U.S.C. §103(a) as being obvious over Morishima et al. in view of Bakewell et al. should be withdrawn. These rejections are withdrawn because Applicant’s Declaration under 37 CFR § 1.131 has established conception and reduction to practice of the invention prior to June 4, 1999, which is prior to May 18, 2000, the publication date of Morishima et al.

¹ The examiner has not reviewed McBride et al.’s provisional applications, so it is not certain the McBride et al. patent has support back to June 05, 1998, the earliest provisional date. If Applicant has not inspected these files and intends to file another 37 CFR § 1.131 declaration establishing invention after June 05, 1998, Applicant should first contact the examiner to see whether McBride et al.’s support extends back to June 05, 1998.

Art Unit: 1753

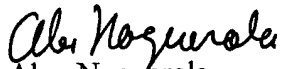
Status of the Rejections pending since the Office Action of May 08, 2003

2. The rejections of claims 1-6 under 35 U.S.C. §112, second paragraph, are withdrawn.
3. The rejections of claims 1, 3, 5, and 6 under 35 U.S.C. §102(a) as being anticipated by Morishima et al are withdrawn.
4. The rejections of claims 1-6 under 35 U.S.C. §103(a) rejections as being obvious over McBride et al. (US 6,296,752 B1), Becker et al. (US 6,287,832 B1), and Bakewell et al. ("Characterization of the dielectrophoretic movement of DNA in micro-fabricated structures") are maintained.
5. The rejections of claims 2 and 4 under 35 U.S.C. §103(a) as being obvious over Morishima et al. in view of Bakewell et al. are withdrawn
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (703) 305-5686. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1753

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Alex Noguera

August 7, 2003